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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			INGBERG, TODD D	
			ART UNIT	PAPER NUMBER
			2193	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/658,684	OTTO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Todd Ingberg	2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 November 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 6/1/2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

Claims 1 – 20 have been examined

Claim 1 was amended.

### *Oath/Declaration*

1. The request has been completed.

### *Information Disclosure Statement*

2. Within the rejection under 103 below the Examiner believes an Information Disclosure Statement on the named products is relevant to the case. Some reference showing the two languages the Applicant is indicating (making a legal claim) makes the invention novel or non-obvious.

### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 - 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The current focus of the Patent Office in regard to statutory inventions under 35 U.S.C. § 101 for method claims and claims that recite a judicial exception (software) is that the claimed invention recite a practical application. Practical application can be provided by a physical transformation or a useful, concrete and tangible result. No physical transformation is recited and additionally, the final result of the claim is a

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converted program which is not a tangible result because claim does not explicitly claim the result as being tangibly embodied on a computer readable medium (write, store etc after the "generating" will overcome this rejection. The following link on the World Wide Web is for the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101.

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\_20051026.pdf>

Amendment overcame the "Signal" rejection under 101.

#### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3 –15, 17-18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Template Software.

The **Template** product line contains:

The SNAP programming language (One manual used)

The Workflow Template (Not used in this Office Action)

The Web Component (One manual used)

These three layered products work together.

The documentation sets for the products contains the following manuals.

**SNAP** released June 1997

SNAP Language Reference ( Not used in this Office Action)

Using the SNAP Language ( Not used in this Office Action)

Using the SNAP Communication Component ( Not used in this Office Action)

Using the SNAP Graphic User Interface Component ( Not used in this Office Action)

Getting Started with SNAP ( Not used in this Office Action)

Using the SNAP Display Editors ( Not used in this Office Action)

SNAP Class Library Reference ( Not used in this Office Action)

Using the SNAP External Application Software Component ( Not used in this Office Action)

Using the SNAP Development Environment (Referred to as **SNAP** )

SNAP Module Library Reference ( Not used in this Office Action)

Using the SNAP Permanent Storage Component ( Not used in this Office Action)

**Workflow** released September 1997

Developing a WFT Workflow System ( Not used in this Office Action)

Using the WFT Development Environment ( Not used in this Office Action)

WFT Library Reference ( Not used in this Office Action)

**Web Component**

Using the Web Component (Referred to as **WEB** )

Since, these products work together they constitute a single reference and can be used as the basis for a rejection based on anticipated by a product offering.

**Claim 1**

Template anticipates a computer program product, tangibly embodied in a storage device, the computer program product being operable to cause data processing apparatus to perform operations comprising: receiving an original design-time representation of an application (SNAP, page 4-8, Creating a GUI) , the original design time representation for use in a first run-time environment for executing applications having been developed in a first design-time environment (SNAP, page 4-9, Steps to make a GUI) , the first design-time environment using a first programming model comprising one or more first model elements including screens and processing logic for each screen, the original design-time representation including one or more application screens (SNAP, pages 4-10 to 4-25) and original processing logic for each

application screen (SNAP, page 4-13, classes); and generating a converted design-time representation of the application based on the original design-time representation (SNAP, page 4-9) , WEB teaches the converted design-time representation for use in a second run-time environment for executing applications having been developed in a second design-time environment (WEB, Chapter 2) , the second design-time environment using a second programming model comprising one or more second model elements including models (WEB, pages 2-13 to 2-19), views, and controllers (WEB, pages 2-3 to 2-5), the converted design-time representation including one or more application views based on the one or more application screens (WEB, pages 2-3 to 2-5), and converted processing logic based on the original processing logic (WEB, pages 2-3 to 2-5), the converted processing logic capable of being executed in the second run-time environment (WEB, pages 2-1 to 2-5).

**Claim 3**

The computer program product of claim 1, wherein generating a converted design-time representation of the application comprises: converting each application screen to a corresponding application view ; and converting the original processing logic for each application screen to the converted processing logic. As per claim 1.

**Claim 4**

The computer program product of claim 3, wherein: each application screen comprises one or more controls from a first set of controls defined in the first programming model; the second programming model defines a second set of controls ; and converting each application screen comprises selecting a corresponding control from the second set of controls for each control in the application screen As per claim 1.

**Claim 5**

The computer program product of claim 4, wherein each control comprises an attribute , and wherein converting each application screen further comprises, for each control in the application screen , setting the attribute of the corresponding control to match the attribute of the control in the application screen As per claim 1.

**Claim 6**

The computer program product of claim 3, wherein the original processing logic comprises state control logic and one or more calls to one or more run-time modules in the first run-time environment , and wherein converting the original processing logic comprises: generating corresponding state control logic that is executable by an adapter in the second run-time environment , the adapter being operable to interface with the run-time modules in the first run-time environment ; and converting the calls to the run-time modules into instructions to the adapter for invoking the run-time modules As per claim 1.

**Claim 7**

The computer program product of claim 3, wherein converting the original processing logic comprises generating one or more instructions to an adapter in the second run-time environment to perform a function not performed by the original processing logic As per claim 1.

**Claim 8**

The computer program product of claim 3, wherein: converting the original processing logic comprises generating code to invoke an adapter in the second run-time environment; and the code to invoke the adapter is formatted to resemble the original processing logic As per claim 1.

**Claim 9**

The computer program product of claim 8, wherein the code to invoke the adapter comprises one or more macros (As per claim 1 – code to convert).

**Claim 10**

A system comprising: a first run-time environment operable to execute run-time code generated from design-time representations of applications developed in a first design-time environment, the first design-time environment using a first programming model comprising one or more first model elements including models, views, and controllers; a conversion module operable to: receive an original design-time representation of an application, the original design-time representation for use in a second run-time environment for executing applications having been developed in a second design-time environment, the second design time environment using a second programming model comprising one or more second model elements including screens and processing logic for each screen, the original design-time representation including one or more application screens and original processing logic for each application screen, the original processing logic including a call to a run-time module in the second run-time environment; and generate a converted design-time representation of the application based on the original design-time representation, the converted design-time representation for use in the first run-time environment, the converted design-time representation including one or more application views based on the one or more application screens, and convert; processing logic based on the original processing logic, the converted processing logic capable of being executed in the first run-time environment; and an adapter operable to interface with the run-time module in the second run-time environment. As per the rejection for claim 1.

**Claim 11**

The system of claim 10, wherein the converted processing logic comprises an instruction to the adapter to invoke the run-time module based on the call to the run-time module in the original processing logic. As per the rejection for claim 1.

**Claim 12**

The system of claim 10, wherein: the first programming model defines a first set of controls; the second programming model defines a second set of controls; and the converted design-time representation of the application comprises a corresponding control from the first set of controls for each control in the original design-time representation of the application. As per the rejection for claim 1.

**Claim 13**

The system of claim 10, wherein the converted processing logic comprises instructions that are formatted to resemble the original processing logic. As per the rejection for claim 1.

**Claim 14**

The system of claim 10, wherein the converted design-time representation of the application comprises additional processing logic not included in the original processing logic. As per the rejection for claim 1.

**Claim 15**

An apparatus comprising: means for receiving an original design-time representation of an application, the original design-time representation for use in a first run-time environment for executing applications having been developed in a first design-time environment, the first design-time environment using a first programming model comprising one or more first model elements including screens and processing logic for each screen, the original design-time representation including one or more application screens and original processing logic for each application screen; and means for generating a converted design-time representation of the application based on the original design-time representation, the converted design-time representation for use in a second run-time environment for executing applications having been developed in a second design-time environment, the second design-time environment using a second programming model comprising one or more second model elements including models, views, and controllers, the converted design-time representation including one or more application views based on the one or more application screens, and converted processing logic based on the original processing logic, the converted processing logic capable of being executed in the second run-time environment. As per the rejection for claim 1.

**Claim 17**

The apparatus of claim 15, wherein the means for generating a converted design-time representation of the application comprises: means for converting each application screen to a corresponding application view; and means for converting the original processing logic for each application screen to the converted processing logic. As per the rejection for claim 1.

**Claim 18**

A method comprising: receiving an original design-time representation of an application, the original design time representation for use. in a first run-time environment for executing applications having been developed in a first design-time environment, the first design-time environment using a first programming model comprising one or more first model elements including screens and processing logic for each screen, the original design-time representation including one or more application screens and original processing logic for each application screen; and generating a ~ -averted design-time representation of the application based on the original design-time representation, the converted design-tune representation for use in second run-time environment for executing applications having been developed in a second design-time environment, the second design-time environment using a second programming model

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comprising one or more second model elements including models, views, and controllers, the converted design-time representation including one or more application views based on the one or more application screens, and converted processing logic based on the original processing logic, the converted processing logic capable of being executed in the second run-time environment. As per the rejection for claim 1.

**Claim 20**

The method of claim 18, wherein generating a converted design-time representation of the application comprises: converting each application screen to a corresponding application view; and converting the original processing logic for each application screen to the converted processing logic. As per the rejection for claim 1.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 16 and 19 are rejected under 35 U.S.C. 102 (b) or 103(a) as being unpatentable over the commercial product line by Template Software in view of Development Tools.

The following is rejected under 102 and 103

**Rejection under 103**

Template teaches the ability to build GUIs in SNAP to run as a local application and how to Web enable them with the product WEB which enables them to run in another environment. therefore, one of ordinary skill in the art would have known to combine the product offerings of Template and use SNAP and enable the applications to run on the WWW, because web enabled applications provide access to do business on the WWW..

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**Claim 2**

The computer program product of claim 1, wherein the first programming model is the SAP Dynpro programming model, and the second programming model is the SAP Web Dynpro programming model.

**Examiner's Interpretation**

Applicant knows best the undisclosed details of SAP Dynpro programming model and SAP Web Dynpro programming model. And if an Information Disclosure Statement is appropriate. The Examiner is presuming the Template SNAP environment meets the functional abilities of SAP Dynpro programming model and the WEB tool of Templates meets the functional abilities of SAP Web Dynpro programming model. Product names not given patentable weight.

**Claim 16**

The apparatus of claim 15, wherein the first programming model is the SAP Dynpro programming model, and the second programming model is the SAP Web Dynpro programming model. As per the rejection for claim 2.

**Claim 19**

The method of claim 18, wherein the first programming model is the SAP Dynpro programming model, and the second programming model is the SAP Web Dynpro programming model. As per the rejection for claim 2.

***Response to Arguments***

9. Applicant's arguments filed November 20, 2006 have been fully considered but they are not persuasive.

**B. Rejections of Claims 1, 3-15, 17-18, and 20 Under 35 U.S.C. § 102(b)**

The following is the Applicant's arguments for the rejections under 102 and 103.

**Applicant's Argument**

"The Examiner asserted that because the SNAP programming language and the Web component "work together, they constitute a single reference and can be used as the basis for a rejection based on" anticipation under 35 U.S.C. § 102(b). (OA at p.4-5.) Applicants respectfully disagree.

The Examiner's assertion is not supported by the current case law of the Federal Circuit. "An 'anticipating reference must describe all of the elements and limitations of the claim in a single reference, and enable one skill in the field of the invention to make and use the claimed invention.' Merck & Co. v. Teva Pharmas. USA. Inc., 347 F.3d 1367, 1372 (Fed. Cir. 2003). "Anticipation under 35 U.S.C. § 102 requires that a single prior art reference disclose each and every limitation of the claimed invention." Moba B.V. v. Diamond Automation, Inc., 325 F.3d 1306, 1322 (Fed. Cir. 2003). Applicants respectfully disagree that two products can constitute a single reference for the purpose of anticipation under 35 U.S.C. § 102 merely because the two products "work together."'"

**Examiner's Response**

Applicant's argument the SNAP programming language and the Web component "work together, they constitute a single reference for the purpose of anticipation under 35 U.S.C. § 102 merely because the two products "work together."", is fundamentally flawed.

In order to have the Web Component SNAP must be present. Once Web functionality is present and the Web component is installed the two are inseparable. Therefore, they are a single offering and constitute a single reference. Applicant has failed to provide compelling case law that deals with dependencies of layered products.

#### Applicant's Argument

"Moreover, even if SNAP and WEB can be combined to constitute a single reference as asserted by the Examiner, the combination of SNAP and WEB fails to teach or suggest every claim element. In particular, the combination of SNAP and WEB fails to teach or suggest "the second design-time environment using a second programming model comprising one or more second model elements including models, views, and controller." The Examiner asserted that WEB discloses the claim element. (OA at p.4.) WEB, however, discloses that "the Web Component libraries convert SNAP application displays to HTML documents or Java applets for display." (WEB p.32). WEB further indicates that the Java applets generated by the Web Components are static Java applets." WEB p.2-3). HTML is a markup language that supports only views. Static Java applets also support only views because static Java applets are used for displaying "charts, canvases, and topologies." WEB p.2-3). Accordingly, WEB fails to teach or disclose models or controller as second model elements, and therefore, fails to teach or disclose "**the second design-time environment using a second programming model comprising one or more second model elements including models, views, and controller.**"

Applicants respectfully submit that the combination of SNAP and WEB fails to support the rejection of independent claims 1, 10, 15, and 18. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of independent claims 1, 10, 15, and 18 and allow the claims."

#### Examiner's Response

The following is the actual rejection for claim 1.

##### **"Claim 1**

Template anticipates a computer program product, tangibly embodied in a storage device, the computer program product being operable to cause data processing apparatus to perform operations comprising: receiving an original design-time representation of an application (SNAP, page 4-8, Creating a GUI) , the original design time representation for use in a first run-time environment for executing applications having been developed in a first design-time environment (SNAP, page 4-9, Steps to make a GUI) , the first design-time environment using a first programming model comprising one or more first model elements including screens and processing logic for each screen, the original design-time representation including one or more application screens (SNAP, pages 4-10 to 4-25) and original processing logic for each application screen (SNAP, page 4-13, classes); and generating a converted design-time representation of the application based on the original design-time representation (SNAP, page 4-9) , WEB teaches the converted design-time representation for use in a second run-time environment for executing applications having been developed in a second design-time environment (WEB, Chapter 2) , **the second design-time environment using a second programming model comprising one or more second model elements including models**

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(WEB, pages 2-13 to 2-19), views, and controllers (WEB, pages 2-3 to 2-5), the converted design-time representation including one or more application views based on the one or more application screens (WEB, pages 2-3 to 2-5), and converted processing logic based on the original processing logic (WEB, pages 2-3 to 2-5), the converted processing logic capable of being executed in the second run-time environment (WEB, pages 2-1 to 2-5)."

The limitations the Applicant states are missing are the converted SNAP to HTML with embedded JAVA the run time support for the deployed environment. Which Applicant makes some recognition of above. The rejection being that the converted program is an programming model by definition a program is a programming model. The format is not a binary 0's and 1's but HTML with embedded JAVA and stored in file which can be directly manipulated. Argument is not persuasive.

#### Applicant's Argument

"Claim 3 depends from claim 1; claims 4 and 6-8 depend from claim 3; claim 5 depends from claim 4; claim 9 depends from claim 8; claims 11-14 depend from claim 10; claim 17 depends from claim 15; and claim 20 depends from claim 18. As explained above, SNAP and WEB do not support the rejection of claims 1, 10, 15, and 18 under § 102. Accordingly, SNAP and WEB do not support the rejection of claims 3-9, 11-14, 17, and 20 under § 102 for at least the same reasons set forth above in connection with claims 1, 10, 15, and 18. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claims 3-9, 11-14, 17, and 20 and allow the claims."

#### Examiner's Response

For the same reasons above the arguments are not persuasive.

### **C. Rejections of Claims 2, 16, and 19 Under 35 U.S.C. §§ 102(b) or 103(a)**

#### Applicant's Argument

"Claim 2 depends from claim 1, claim 16 depends from claim 15, and claim 19 depends from claim 18. Accordingly, claims 2, 16, and 19 are allowable at least by virtue of their dependence on allowable claims 1, 15, and 18, respectively. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claims 2, 16, and 19 and allow the claims.

#### (1) Rejections of Claims 2, 16, and 19 Under 35 U.S.C. §102(b)

The Examiner rejected claims 2, 16, and 19 under 35 U.S.C. § 102(b) "as being unpatentable over the commercial product line by Template Software in view of Development Tools." (OA p.8.) As explained above in connection with claims 1, 10, 15, and 18, the rejection of claims 2, 16, and 19 cannot be supported by the current case law of the Federal Circuit. Two products cannot constitute a single reference for the purpose of anticipation under 35 U.S.C. § 102. Moreover, the combination of SNAP and WEB fails to teach or suggest every claim element. Accordingly, Applicants respectfully request that the rejection of claims 2, 16, and 19 under 35 U.S.C. § 102(b) be withdrawn."

#### Examiner's Response

Argument responded to above.

#### Applicant's Argument

#### "(2) Rejections of Claims 2, 16, and 19 Under 35 U.S.C. § 103(a)

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The Examiner, alternatively, rejected claims 2, 16, and 19 under 35 U.S.C. § 103(a) "as being unpatentable over the commercial product line by Template Software in view of Development Tools." (OA p.8.) The Examiner asserted that "Template teaches the ability to build GUIs in SNAP to run as a local application and how to Web enable them with the product WEB which enables them to run in another environment." (OA p.8.)

Applicants respectfully submit that no prima facie case of obviousness exists with respect to claim 2 for at least the reason that SNAP in view of WEB fails to teach or suggest every claim element. To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, all the claim elements must be taught or suggested by the prior art. See M.P.E.P. § 2143.03 (8th ed., rev. 5, August 2006). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Each of these requirements must "be found in the prior art, not in Applicant's discloser." See M.P.E.P. § 2143 (8th ed., rev. 5, August 2006)."

#### **Examiner's Response**

The rejection for claim 2 is as follows:

#### **"Claim 2**

The computer program product of claim 1, wherein the first programming model is the SAP Dynpro programming model, and the second programming model is the SAP Web Dynpro programming model.

#### **Examiner's Interpretation**

Applicant knows best the undisclosed details of SAP Dynpro programming model and SAP Web Dynpro programming model. And if an Information Disclosure Statement is appropriate. The Examiner is presuming the Template SNAP environment meets the functional abilities of SAP Dynpro programming model and the WEB tool of Templates meets the functional abilities of SAP Web Dynpro programming model. Product names not given patentable weight."

It is the Applicant who holds relevant information pertaining to the case on commercial product they clearly must be in possession. For the Applicant to claim to convert from one SAP product to another SAP product they must be in possession of a teaching that enabled them to define the input and output. Yet, the record is silent as to any disclosure.

The following is from the MPEP:

#### **"2001 Duty of Disclosure, Candor, and**

#### **Good Faith**

*37 CFR 1.56. Duty to disclose information material to patentability.*

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from

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consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) Prior art cited in search reports of a foreign patent office in a counterpart application, and.
  - (2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.
- (b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and
- (1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim; or
  - (2) It refutes, or is inconsistent with, a position the applicant takes in:
    - (i) Opposing an argument of unpatentability relied on by the Office, or
    - (ii) Asserting an argument of patentability.

A *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

- (c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:
- (1) Each inventor named in the application;
  - (2) Each attorney or agent who prepares or prosecutes the application; and
  - (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.
- (d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.
- (e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability, as defined paragraph (b) of this section, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.
- 37 CFR 1.56 defines the duty to disclose information to the Office.

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## **2001.01 Who Has Duty To Disclose**

*37 CFR 1.56. Duty to disclose information material to patentability.*

\*\*\*\*\*

- (c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:
- (1) Each inventor named in the application;
  - (2) Each attorney or agent who prepares or prosecutes the application; and
  - (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

\*\*\*\*\*

Individuals having a duty of disclosure are limited to those who are "substantively involved in the preparation or prosecution of the application." This is intended to make clear that the duty does not extend to typists, clerks, and similar personnel who assist with an application.

The word "with" appears before "the assignee" and anyone to whom there is an obligation to assign" to make clear that the duty applies only to individuals, not to organizations. For instance, the duty of disclosure would not apply to a corporation or institution as such. However, it would apply to individuals within the corporation or institution who were substantively involved in the preparation or prosecution of the application, and actions by such individuals may affect the rights of the corporation or institution.

## **2001.03 To Whom Duty of Disclosure Is Owed [R-2]**

37 CFR 1.56(a) states that the "duty of candor and good faith" is owed "in dealing with the Office" and that all associated with the filing and prosecution of a patent application have a "duty to disclose to the Office" material information. This duty "in dealing with" and "to" the Office extends, of course, to all dealings which such individuals have with the Office, and is not limited to representations to or dealings with the examiner. For example, the duty would extend to proceedings before the Board of Patent Appeals and Interferences and the Office of the \* Commissioner for Patents.

## **2001.04 Information Under 37 CFR**

### **1.56(a) [R-2]**

*37 CFR 1.56. Duty to disclose information material to patentability.*

- (a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective

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patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) Prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office."

With the lack of disclosure of why a specific Commercial product's code is converted into another product code from the same vendor. The Examiner with the information accessible and disclosed by Applicant made the following determination.

**Applicant's Argument**

"In response to the Examiner's comments that the "product names not given patentable weight," Applicants respectfully submit that claims 2, 16, and 19 recite the product names not as patentable inventions but to further describe the claimed inventions under claims 2, 16, and 19."

**Examiner's Response**

Had the specifics of the commercial products been so relevant to the invention the relevant information would have been disclosed to the Office. One of ordinary skill in the art does not know nor would be expected to know the syntax and semantics of every tool. The Examiner in view of the specification made a functional determination of the two Template references providing like functionality.

**Applicant's Argument**

"Claim 2 recites that "the second programming model is the SAP Web Dynpro programming model." WEB teaches or suggests neither the SAP Web Dynpro programming model nor that "the second programming model is the SAP Web Dynpro programming model." The Examiner, however, asserted the rejection based on the presumption that "the WEB tool of Templates meets the functional abilities of SAP Web Dynpro programming model." (OA. p.8). In light of the SAP Web Dynpro programming model disclosed in the specification, Applicants respectfully disagree."

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**Examiner's Response**

Answered above.

**Applicant's Argument**

"WEB discloses that "the Web Component libraries convert SNAP application displays to HTML documents or Java applets for display." (WEB p.3-2). WEB further indicates that the Java applets generated by the Web Components are "static Java applets." (WEB p.2-3). HTML is a markup language that supports only views. Static Java applets also support only views because static Java applets are used for displaying "charts, canvases, and topologies." (WEB p.2-3). Although the Web Component libraries also "convert end-user input to the types of data and events that" SNAP applications expect, the part of SNAP applications that the Web Component libraries convert is limited to the applications' displays. (WEB p.3-2). Because of these limitations, WEB specifically mentions that "certain features of SNAP do not operate over the web, because of the structure and limitations of HTML and of the various web browser programs." (WEB p.2-3).

The SAP Web Dynpro programming model, however, supports the model-view controller (MVC) programming model that the WEB tool of Templates fails to support. As a result, the conversion of the original design-time representation need not be limited to its displays. Therefore, the presumption that the WEB tool of Templates meets the functional abilities of SAP Web Dynpro programming model is invalid."

**Examiner's Response**

No limitations are present to distinguish Applicant's argument from what they present is a difference.

**Applicant's Argument**

"As explained above, WEB fails to teach or suggest that "the second programming model is the SAP Web Dynpro programming model." Therefore, WEB fails to cure the deficiency of SNAP as the Examiner asserted. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 2 and allow the claim."

**Examiner's Response**

Answered above.

**Applicant's Argument**

"Applicants respectfully submit that no *prima facie* case of obviousness exists with respect to claim 16 for at least the reason that SNAP in view of WEB fails to teach or suggest every claim element. For example, claim 16 recites that "the second programming model is the SAP Web Dynpro programming model." As explained above in connection with claim 2, WEB fails to teach or suggest that "the second programming model is the SAP Web Dynpro programming model." Therefore, WEB fails to cure the deficiency of SNAP as the Examiner asserted. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 16 and allow the claim."

**Examiner's Response**

Answered above

**Applicant's Argument**

"Applicants respectfully submit that no prima facie case of obviousness exists with respect to claim 19 for at least the reason that SNAP in view of WEB fails to teach or suggest every claim element. For example, claim 19 recites that "the second programming model is the SAP Web Dynpro programming model." As explained above in connection with claim 2, WEB fails to teach or suggest that "the second programming model is the SAP Web Dynpro programming model." Therefore, WEB fails to cure the deficiency of SNAP as the Examiner asserted. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 19 and allow the claim."

**Examiner's Response**

Examiner disagrees. Applicant has not identified distinguishing limitations over the assertions the Examiner made given the information disclosed.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

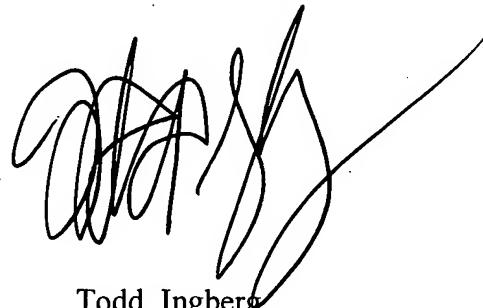
***Correspondence Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd Ingberg whose telephone number is (571) 272-3723. The examiner can normally be reached on during the work week..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Todd Ingberg  
Primary Examiner  
Art Unit 2193

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